

REMARKS

This amendment and response is filed in response to the Office Action dated December 4, 2003, in which the Examiner has: objected to the Specification; objected to claims 1, 2, 9-11, 18, 19 and 23 based upon informalities; rejected claims 1-4, 10-13 and 18-23 under 35 U.S.C. § 102(b) as being anticipated by Goffman, U.S. Patent No. 5,594,897; and rejected Claims 5-9, 14-17 and 24 under 35 U.S.C. § 102(e) as being anticipated by Lawrence et al., U.S. Patent No. 6,289,342.

By this amendment, the specification and claims 1, 2, 5, 9-11, 14, 18, 19, 23 and 24 have been amended. Claims 1-24 are pending. Applicant respectfully submits that all pending claims are now in a position of allowance, and requests favorable action to that effect.

Specification: Incorporation by Reference

In the instant Office Action, it has been indicated that “[t]he attempt to incorporate subject matter into this application by reference to the numerous publications listed from Page 18, Line 12 to Page 19, Line 8 is improper because ‘essential material’ may not be incorporated by reference to non-patent publications,” and that “[t]he statistical analyses disclosed in these are ‘essential material’ because they are necessary to describe the claimed invention. See MPEP § 608.01(p).”

With respect to incorporation of these references, applicant respectfully notes (1) that these articles are indeed briefly mentioned at the beginning of the statistical analysis section as “examples of techniques to determine attributes”; yet, much more

importantly (2) that the subsequent 5 pages of the written description (the remainder of page 19 and the following 4 pages) goes on to set forth several more specific statistical analysis routines in great detail. Thus, it is respectfully submitted not only that the “determining attributes” and “statistically analyzing” language of the claimed invention are fully supported by, inter alia, these 5 pages of the written description, but that pages 19-23 also provide all of the completeness¹ that the application requires for 35 U.S.C. § 112 with respect to any potential incorporation defects (in other words, given this written description support, it cannot be properly said that the incorporated publications are necessary to (1) describe the invention, (2) to provide an enabling disclosure, or (3) to describe the best mode, and thus are not “essential material” as defined by MPEP § 608.01(p)(I)(A)).

Therefore, the numerous publications listed from Page 18, Line 12 to Page 19, Line 8 may be properly incorporated by reference, and applicant respectfully submits that no correction is required.

It has also been indicated that “[t]he attempt to incorporate subject matter into this application by reference to the numerous publications listed from Page 27, Lines 10-13 is improper because ‘essential material’ may not be incorporated by reference to non-patent publications,” and that “[t]he information visualization spreadsheets disclosed in these publications are ‘essential material’ because they are necessary to describe the claimed invention. See MPEP § 608.01(p).”

¹ This is not an indication that no other portions of the specification pertain to any of the issues (e.g., scope) being discussed, rather just that this section (pp. 19-23), by itself, possesses sufficient description.

As with the above-discussed publications, applicant respectfully submits that the two journal articles on page 27 subject to the instant discussion similarly are not "essential material," for two separate and distinct reasons, and may also be properly incorporated by reference. First, it is noted that all of the subject publications on page 27 of the written description are provided simply as examples of an alternate way a user could arrange the resulting information (i.e., alternate to the mere "display" of the statistical results as seen, e.g., in Figs. 12A-12K and the related written description). Thus, again, this material pertaining to this alternate 'arrangement' functionality is not necessary (1) to describe the invention, (2) to enable the invention, or (3) to describe the best mode, since a preferred functionality (*display* of the statistical analysis) is set forth in the application in such a way as to adequately describe and enable this aspect of the invention.

Secondly and moreover, one such alternate way a user could arrange this information *is* set forth sufficiently by reference to U.S. Patent No. 5,689,287 ("the '287 patent), which is incorporated by reference. The '287 patent provides information pertaining to "perspective walls," which is another technique of the greater "structuring substrates" aspect, of which the "information visualization spreadsheets" technique is also a subset. Therefore, the "structuring substrates" manner of arranging information *is*, indeed, fully provided in the written description -- here, by incorporating the '287 patent to describe the "perspective wall" technique -- and therefore material describing "information visualization substrates" (a parallel, or alternate, to the "perspective walls" technique) is not "essential" material.

Similarly, the Office Action also expresses a similar incorporation by reference problem with respect to the materials cited after the “perspective walls” term. As explained immediately above, the U.S. patent cited in this section, the ‘287 patent, adequately describes and enables the greater, alternate arrangement of information that is the subject of this paragraph of the written description. Thus, the article immediately preceding the ‘287 patent in the text is not “essential material” to the presently prosecuted claims, and applicant respectfully states that no correction therefore need be made to its incorporation by reference.

Specification: Objections to Language

The disclosure has been objected to due to three typographical errors, namely, the terms “selecting” (p. 28, line 21), “provided” (p. 30, line 7) and “discussed” (p. 34, line 6). As seen in the Amendments to the Specification section above, applicant has made the changes suggested by the Examiner (to “selected,” “provide” and discussion,” respectively), and respectfully submits that these objections have been overcome.

Objections to Claims 1, 2, 9-11, 18, 19 and 23

Claims 1, 9 and 18 has been objected to because of the informality that the phrase “the steps of” should have been inserted at the end of the preamble language of these three claims.

Applicant agrees with the Examiner, and has made the amendments that were suggested. As seen in the Claim Amendment section above, the phrase “the steps of”

has been added to claims 1, 9 and 18 to reflect that the recited elements are method steps.

Claims 2, 11 and 19 have been objected to because of the informality (typographical error) that the term "statistical" in claims 2, 11 and 19 should be "statistically." Again, applicant recognizes and has acquiesced to the Examiner's suggestion. Claims 2, 11 and 19 have been amended to correct this term to "statistically," as shown above.

Based on informalities, Claim 10 has been objected to: because the word "storage" was missing from line 1, providing a lack of proper basis for the expression "the storage medium" used later in the claim; because the phrase "computer-readable" should be inserted at line 3, and the phrase "that cause the apparatus" should be inserted in line 6 in order to more clearly "indicate that the apparatus is a computer system and has a utility"; and, because the "gathers" should be "gather" in line 6.

Applicant agrees with and expresses appreciation for the Examiners suggestions. The appropriate changes, as seen above, have been made to claim 10.

Claim 23 has been objected to because of the informality that the term "comprising" in Line 3 should be amended to "said method comprising the steps of," to more properly reflect that the claim is for a method that is embodied on computer software.

Once again, applicant has made this and the other amendment suggested. Accordingly, applicant requests that these objections be withdrawn.

Rejection of Claims 1-4, 10-13 and 18-23 under 35 U.S.C. § 102(b)

Claims 1-4, 10-13 and 18-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Goffman, U.S. Patent No. 5,594,897 ("Goffman"). It has been argued that Goffman discloses "a method of producing a storage medium that provides information regarding a source material (Column 7, Line 3 through Column 8, Line 2 - the 'source material' is the 'starter' journal)" as well as other elements in the claims.

Applicant has amended all the independent claims (1, 10 and 18) affected by this rejection, and respectfully submits that these claims, as amended, are patentable over Goffman (and over the other cited art of record, as well). For instance, claim 1 is drawn to a method of producing a storage medium including the steps of gathering features of the source material, accessing secondary materials related to the features, gathering features of the secondary materials, determining attributes of the gathered materials, analyzing the attributes based on a predetermined characteristic, and recording information regarding the source material and the secondary materials based on the analysis. It has been amended to further recite "wherein the recorded information includes relational information between the source material or one or more of the secondary materials and at least one of the gathered features, the determined attributes or the predetermined characteristic, and wherein the relational information is used in the provision of the information contained within the storage medium."

While it is believed that the independent claims are distinguishable from the cited reference based on the interrelated functionality of the stated steps alone, claim 1 has been amended to more clearly claim the invention, better clarifying the basis for patentability over Goffman. Claim 1 is a method of producing a storage medium that

contains information recorded after specific gathering, accessing, determining and analyzing steps have occurred. As a result of the claimed method steps, a storage medium is produced that contains information processed into a more valuable, useful and desired variety, enabling such advantageous functionality as providing specific recommendations for reading based on user input. Hence the relevant claim language has been changed to better clarify this processed (e.g., relational) information, so as to more clearly claim the invention.

In contrast, Goffman fails to teach or suggest the claimed invention. Goffman is directed to a straightforward algorithm designed to select a core (e.g., most important) set of objects from a larger overall source collection. The only analysis performed by Goffman is a simple perusal of the data tree structure between items in the source collection to determine one's dominance over another; the core items are then selected according to dominance. A hit list of these "core" objects is then provided. Thus, Goffman neither teaches nor suggests the processing and recording of information as set forth in the original claims, and certainly does not disclose the use of relational data, as has now been set forth in the currently amended versions of these claims to more clearly claim the invention.

As with claim 1, independent claims 10 and 18 have also been changed in like fashion to recite this clarification. Therefore, in view of the presently amended claims, applicant respectfully submits that the rejection of claims 1-4, 10-13 and 18-23 under 35 U.S.C. § 102(b) based on Goffman has been overcome, and should be withdrawn.

Rejection of Claims 5-9, 14-17 and 24 under 35 U.S.C. § 102(e)

Claims 5-9, 14-17 and 24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lawrence et al., U.S. Patent No. 6,289,342 ("Lawrence"), with the indication that Lawrence discloses a method of providing an interface for graphically displaying information according to the steps/computer software set forth in these claims.

It is respectfully submitted that Lawrence does not sufficiently teach or suggest the limitations of independent claims 5, 14 and 24, particularly as clarified by amendment, so as to render any of claims 5-9, 14-17 and 24 anticipated. Lawrence discloses an automatic citation indexing system designed for identifying similar citations in a source document, even citations differing in syntax; the system can also "extract[] and provide[] the context of citations to a given paper, allowing a researcher to determine what is published in other papers about a given paper." (Abstract) However, as seen in the specification (columns 1-22; columns 5-22, in particular) and the figures (Figs. 1-7 are just hit lists, and Figs. 8-10 are hit lists with simple word/phrase comparison), the method/interface (and related computer-readable medium) of Lawrence only operate to provide the source document and/or a list of documents (and document information) derived by means of predefined (e.g., keyword) search mechanisms.

In contrast to Lawrence, the relevant independent claims of the present invention (claims 5, 14 and 24), are directed to a method of providing an interface, an interface, and a computer readable medium, respectively, including analysis that yields relational information between "the source material or one or more of the secondary materials"

and at least one of "the selection of information" based on the user input and/or "the information regarding the source materials," as well as the subsequent update of the display of information based on such relational information. Thus, while it is believed that Lawrence does not teach or suggest the 'analysis' described in the original claims, applicant has added language that now better clarifies how the claims define over this reference. In this regard, independent claims 5, 14 and 24 have been amended to more clearly claim the invention.

Applicant thus respectfully submits that independent claims 5, 14 and 24, as amended, as well as their dependent claims (claims 6-9 and 15-17), are not taught or suggested by Lawrence. Therefore, applicant courteously requests removal of the instant rejection, under 35 U.S.C. 102(e), concerning claims 5-9, 14-17 and 24.

In view of the foregoing amendments and remarks, Applicant submits that the pending claims are in allowable form, and respectfully requests reconsideration of the objections/rejections and the timely allowance of the claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Xerox's deposit account 24-0037.

Respectfully submitted,

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